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EPISTAR CORP. and UNITED EPITAXY CO., LTD.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

LUMILEDS LIGHTING U.S., LLC,

Plaintiff,

v.

EPISTAR CORP., and UNITED EPITAXY
CO., LTD.,

Defendants.

Case No. C-05-04521 RMW

**DEFENDANTS EPISTAR CORP. AND
UNITED EPITAXY CO., LTD.'S NOTICE
OF MOTION AND MOTION FOR STAY
PURSUANT TO 28 U.S.C. § 1659;
MEMORANDUM OF POINTS AND
AUTHORITIES**

Date: February 3, 2006

Time: 9:00 a.m.

Courtroom: 6

Judge: Hon. Ronald M. Whyte

1 TO LUMILEDS LIGHTING U.S., LLC AND ITS COUNSEL OF RECORD:

2 PLEASE TAKE NOTICE THAT defendants Epistar Corporation (“Epistar”) and United
3 Epitaxy Co., Ltd, (“UEC”) (collectively “Defendants”), by and through the undersigned attorneys, at
4 9:00 a.m. on February 3, 2006 at the above referenced courtroom located at 280 South First Street, San
5 Jose, California, will and hereby do move the Court, pursuant to 28 U.S.C. § 1659, for an order staying
6 all proceedings in this case until final resolution of the related investigation pending before the United
7 States International Trade Commissions, entitled *In the Matter of Certain High-Brightness Light*
8 *Emitting Diodes and Products Containing same*, Inv. No. 337-TA-556.

9 As grounds for this motion, as set forth more fully in the Memorandum of Points and
10 Authorities below, Defendants state:

11 1. Plaintiff Lumileds Lighting U.S., LLC (“Lumileds”) filed the above entitled action on
12 November 4, 2005;

13 2. Lumileds also filed a complaint with the United States International Trade Commission
14 (the “ITC”) on November 4, 2005, alleging that the Defendants herein are in violation of section 337
15 of the Tariff Act of 1930, 19 U.S.C. § 1337, on the same grounds as were alleged in the Complaint
16 herein;

17 3. On December 2, 2005, the Commission issued a Notice of Investigation (attached
18 hereto as “Exhibit B”) formally instituting Investigation No. 337-TA-556, and naming the Defendants
19 herein as Respondents thereto; and

20 4. Defendants are entitled to stay this District Court case pending resolution of the ITC
21 investigation as a matter of right under 28 U.S.C. § 1659.

22 Defendants therefore request that the action in this Court be stayed for all purposes pursuant to
23 28 U.S.C. § 1659 until the determination of the Commission in Investigation No. 337-TA-556 becomes
24 final. Counsel for Defendants has discussed this matter with counsel for Plaintiff and is informed that
25 plaintiff does not oppose this motion.

26 **MEMORANDUM OF POINTS AND AUTHORITIES**

27 Upon the request of any party to a civil action that is also a respondent in an ITC investigation,
28 the Court “shall stay, until the determination of the Commission becomes final, proceedings in the civil

1 action with respect to any claim that involves the same issues involved in the proceeding before the
 2 Commission.” 28 U.S.C. § 1659(a). The requested stay is mandatory and may be denied only if the
 3 request is not made at the later of 30 days after the institution of the Commission investigation or 30
 4 days after the civil complaint is filed. *Id.*

5 All of Lumileds’ claims in this civil action are involved in the ITC investigation. In its
 6 complaint, Lumileds alleges infringement of U.S. Patent Nos. 5,008,718 (“the ’718 patent”), 5,376,580
 7 (“the ’580 patent”), and 5,502,316 (“the ’316 patent”). More specifically, Lumileds alleges that Epistar
 8 infringes the ’580 and the ’316 patents, and UEC infringes the ’718, the ’580, and the ’316 patents.
 9 Feng Decl., Ex. A. The same claims are also at issue in the ITC investigation. *Id.* Ex. B. Moreover,
 10 this motion is timely raised. The ITC published its Notice of Investigation naming Defendants as
 11 Respondents in the ITC investigation on December 2, 2005. This motion is filed December 30, within
 12 the 30 days allowed by statute. 28 U.S.C. § 1659(a)(1).

13 For these reasons, Defendants respectfully request that the Stay be issued.

14
 15 Dated: December 30, 2005

AKIN GUMP STRAUSS HAUER & FELD LLP

16
 17 By _____/s_____
 18 Sean P. DeBruine

19 Attorneys for Defendants
 20 EPISTAR CORP. and UNITED EPITAXY CO.,
 21 LTD.